

Appl. No. : 10/682,379  
Filed : October 9, 2003

### **REMARKS**

The foregoing amendments and the following remarks are responsive to the November 14, 2006 Office Action. Claims 1, 26, and 30 remain as previously presented, Claims 2-21, 23-25, 28, and 29 remain as originally filed, and Claims 22, 27, and 31-66 are cancelled without prejudice. Thus, Claims 1-21, 23-26, and 28-30 are presented for further consideration. Please enter the amendments and reconsider the claims in view of the following remarks.

#### **Comments on Personal Interview with Examiner**

Applicants thank Examiner Shay for extending the courtesy of conducting a personal interview with co-inventor, Luis De Taboada, and Applicants' representative, Bruce Itchkawitz, on March 20, 2007 in which the patentability of the claims were discussed. The amendments and remarks herein are in accordance with this discussion.

During the interview, the Examiner agreed that Claims 1-21, 23-36, and 28-30 were allowable over the prior art in view of the showing that one having ordinary skill in the art at the time of the invention would have believed that the transmission characteristics of brain tissue were much smaller than was determined by Applicants. In addition, Applicants agreed to the cancellation of Claims 37-41, 44-46, and 50-66 by examiner's amendment. The "Amendments to the Claims" section of this response reflect the cancellation of Claims 37-41, 44-46, and 50-66 without prejudice.

#### **Response to Rejection of Claim 59 Under 25 U.S.C. § 112, First Paragraph**

In the November 14, 2006 Office Action, the Examiner rejects Claim 59 under 35 U.S.C. § 112, first paragraph as failing to comply with the written description requirement. Applicants respectfully traverse this rejection, but in the interest of expediting allowance of the application, have cancelled Claim 59 without prejudice. Applicants respectfully request that the Examiner consider the patentability of the remaining pending claims.

#### **Response to Rejection of Claims 1-6, 8-10, 14, 19, 23-26, and 28-30 Under 35 U.S.C. § 102(b)**

In the November 14, 2006 Office Action, the Examiner rejects Claims 1-6, 8-10, 14, 19, 23-26, and 28-30 under 35 U.S.C. § 102(b) as being anticipated by U.S. Patent No. 6,537,304 issued to Oron ("Oron") in view of B. Chance *et al.*, "Comparison of time-resolved and -unresolved measurements of deoxyhemoglobin in brain," Proc. Natl. Acad. Sci., Vol. 85, pages 4971-4975, July 1988 ("Chance"). In view of the discussion during the March 20, 2007

**Appl. No.** : 10/682,379  
**Filed** : October 9, 2003

interview, Applicants submit that Claims 1-6, 8-10, 14, 19, 23-26, and 28-30 are patentably distinguished over Oron in view of Chance, and respectfully requests that the Examiner pass these claims to allowance.

**Response to Rejection of Claims 37, 38, 44-46, 51-54, and 57-59 Under 35 U.S.C. § 103(a)**

In the November 14, 2006 Office Action, the Examiner rejects Claims 37, 38, 44-46, 51-54, and 57-59 under 35 U.S.C. § 103(a) as being unpatentable over Oron in combination with Chance and U.S. Patent No. 6,312,451 issued to Streeter ("Streeter"). Applicants respectfully traverse this rejection, but in the interest of expediting allowance of the application, have cancelled Claims 37, 38, 44-46, 51-54, and 57-59 without prejudice. Applicants respectfully request that the Examiner consider the patentability of the remaining pending claims.

**Response to Rejection of Claims 7, 15-18, and 20 Under 35 U.S.C. § 103(a)**

In the November 14, 2006 Office Action, the Examiner rejects Claims 7, 15-18, and 20 under 35 U.S.C. § 103(a) as being unpatentable over Oron in combination with Chance, U.S. Patent No. 5,643,334 issued to Eckhouse *et al.* ("Eckhouse") and U.S. Patent No. 5,282,797 issued to Chess ("Chess"). In view of the discussion during the March 20, 2007 interview, Applicants submit that Claims 7, 15-18, and 20 are patentably distinguished over Oron in view of Chance, and respectfully requests that the Examiner pass these claims to allowance.

**Response to Rejection of Claim 21 Under 35 U.S.C. § 103(a)**

In the November 14, 2006 Office Action, the Examiner rejects Claim 21 under 35 U.S.C. § 103(a) as being unpatentable over Oron in combination with Chance and Eckhouse. In view of the discussion during the March 20, 2007 interview, Applicants submit that Claim 21 is patentably distinguished over Oron in view of Chance, and respectfully requests that the Examiner pass this claim to allowance.

**Response to Rejection of Claims 11-13 Under 35 U.S.C. § 103(a)**

In the November 14, 2006 Office Action, the Examiner rejects Claims 11-13 under 35 U.S.C. § 103(a) as being unpatentable over Oron in combination with Chance, Eckhouse, U.S. Patent No. 5,474,528 issued to Meserol ("Meserol"), and U.S. Patent No. 5,622,168 issued to Kuesch *et al.* ("Kuesch"). In view of the discussion during the March 20, 2007 interview, Applicants submit that Claims 11-13 are patentably distinguished over Oron in view of Chance, and respectfully requests that the Examiner pass these claims to allowance.

Appl. No. : 10/682,379  
Filed : October 9, 2003

**Response to Rejection of Claims 39-41 Under 35 U.S.C. § 103(a)**

In the November 14, 2006 Office Action, the Examiner rejects Claims 39-41 under 35 U.S.C. § 103(a) as being unpatentable over Oron in combination with Chance, U.S. Patent No. 6,045,575 issued to Rosen *et al.* ("Rosen"), and Meserol. Applicants respectfully traverse this rejection, but in the interest of expediting allowance of the application, have cancelled Claims 39-41 without prejudice. Applicants respectfully request that the Examiner consider the patentability of the remaining pending claims.

**Response to Rejection of Claims 55, 56, and 60-66 Under 35 U.S.C. § 103(a)**

In the November 14, 2006 Office Action, the Examiner rejects Claims 55, 56, and 60-66 under 35 U.S.C. § 103(a) as being unpatentable over Oron in combination with Chance and U.S. Patent No. 6,277,974 issued to Lo *et al.* ("Lo"). Applicants respectfully traverse this rejection, but in the interest of expediting allowance of the application, have cancelled Claims 55, 56, and 60-66 without prejudice. Applicants respectfully request that the Examiner consider the patentability of the remaining pending claims.

**Response to Rejection of Claim 50 Under 35 U.S.C. § 103(a)**

In the November 14, 2006 Office Action, the Examiner rejects Claim 50 under 35 U.S.C. § 103(a) as being unpatentable over Oron in combination with Chance, Streeter, and U.S. Patent No. 6,551,308 issued to Mueller *et al.* ("Mueller"). Applicants respectfully traverse this rejection, but in the interest of expediting allowance of the application, have cancelled Claim 50 without prejudice. Applicants respectfully request that the Examiner consider the patentability of the remaining pending claims.

**Summary**

Applicants submit that Claims 1-21, 23-26, and 28-30 are in condition for allowance, and such action is respectfully requested.

Please charge any additional fees, including any fees for additional extension of time, or credit overpayment to Deposit Account No. 11-1410.

Respectfully submitted,

Dated: \_\_\_\_\_

4/5/07

By: \_\_\_\_\_

Bruce S. Itchkawitz  
Registration No. 47,677  
KNOBBE, MARTENS, OLSON & BEAR, LLP

**Appl. No.** : **10/682,379**  
**Filed** : **October 9, 2003**

Attorney of Record  
2040 Main Street  
Fourteenth Floor  
Irvine, CA 92614  
(949) 760-0404

3617134  
040507